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VOLPE AND KOENIG, P.C.  
UNITED PLAZA, SUITE 1600  
30 SOUTH 17TH STREET  
PHILADELPHIA PA 19103

In re Application of  
KNIGHT (deceased) et al.  
Serial No.: 10/585,829  
PCT No.: PCT/AU04/01733  
Int. Filing Date: 10 December 2004  
Priority Date: 13 January 2004  
Atty. Docket No.: MOR3-PT023  
For: BRIDGING BEAM

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: DECISION ON  
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: DECLARATION  
:  
: UNDER 37 CFR 1.42  
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This is in response to applicant's Declaration which was filed in the United States Patent and Trademark Office on 12 November 2008. Applicant's request for a two month extension of time is granted.

### **BACKGROUND**

On 13 June 2008, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b), was required.

On 12 November 2008, applicant filed a declaration executed by two of three inventors named in the international application along with the \$65 surcharge for filing the declaration after the thirty month period and a request for an extension of time. The declaration was allegedly executed by the apparent heir to a deceased inventor.

### **DISCUSSION**

37 CFR § 1.42 requires that in the case of the death of the inventor, the legal representative of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent.

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal representative. The declaration must also state the citizenship, residency and last mailing address of the deceased inventor to comply with 37 CFR 1.497(a)(3).

The executed declaration submitted on 12 November 2008, identified the inventors as John Keith Knight, Robert Edwin Randell and Carmel Geraldine Chell. Counsel of record stated that the declaration was executed by Mr. Knight's widow. However, the declaration did not identify her as the legal representative or the heir of the deceased inventor. This declaration is unacceptable with regard to the deceased inventor and his heir(s).

The execution of the declaration for deceased inventor does not meet the requirements of 37 CFR 1.497(b). Although the declaration identifies John Keith Knight, it does not identify Beverly Anne Knight as the sole heir of deceased inventor

It is unclear whether Beverly Anne Knight is the only heir of deceased inventor Knight. If she is not the only heir, the declaration must be executed by all of the heirs of the deceased inventor. It is also unclear whether a legal representative of the deceased's estate has been appointed or is statutorily required to be appointed. (Applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.)

In situations where it is not clear that the declaration includes the signatures of all the heirs (e.g., indicates heir/heirs as opposed to sole heir/all heirs), the Office requires a statement by either those signing or the attorney which sets forth that they are in fact all the heirs of the deceased inventor. The statement must also set forth that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed.

The declaration is also defective because it does not state the country of citizenship, residency and mailing address for *both* the deceased inventor and the heir, to meet the requirements for compliance with 37 CFR 1.497.

The requirements of 37 CFR 1.497 (a) and (b) have not been met and the declaration is unacceptable as filed. Accordingly, it is inappropriate, at this time, to accord the application status under 37 CFR 1.42. The declaration is unacceptable under 37 CFR 1.497 (a) and (b).

### CONCLUSION

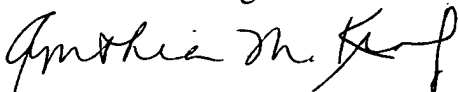
For the above reasons, the request for status under 37 CFR 1.42 and 37 CFR 1.497(d) is **DISMISSED WITHOUT PREJUDICE.**

Applicant is required to submit a statement by either those signing or the attorney which sets forth that they are in fact all the heirs of the deceased inventor. Such statement must also set forth that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed.

What is required is a newly executed declaration, in accord with the requirements of 37 CFR 1.497(a) and (b), where the heir(s) of the deceased inventor has signed in accord with this decision.

Applicant must respond within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Cynthia M. Kratz  
Attorney Advisor  
PCT Legal Office  
Telephone: 571-272-3286  
Facsimile: 571-273-0459